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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,214	04/26/2000	Shuji Kuhara	049390-5003	9813

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EXAMINER

MATHEWS, ALAN A

ART UNIT

PAPER NUMBER

2851

DATE MAILED: 05/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/558,214

Applicant(s)

KUHARA, SHUJI

Examiner

Alan A. Mathews

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claim 2-4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 2, lines 1 and 2, "said previous printing is simultaneous printing" is indefinite. The expression does not correlate what process is being performed simultaneously with what process. Simultaneous printing with what process? In claim 3, line, 7, it is not clear what the word "catches" means.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

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122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Garfinkle et al (U. S. Patent No. 6,017,157). Garfinkle et al discloses in figure 1 and columns 3 and 4, one or more photographic laboratories 12 (sites) having processing (developing) apparatus. The image server 16 is the center having a database. In column 3, lines 30-32 and lines 43-45, Garfinkle et al discloses an example where developed photographic prints are themselves scanned. The digital images and information from the scanner are sent to the center (image server) 16 where it is stored (see column 4, lines 24-27, 31-33 and boxes 3f in figure 3). The information or data gathered while scanning these prints would inherently include photographic printing conditions, since it is scanning the current condition of the print. A user can order another print or prints at a later time based on the conditions of the first print. It is further noted that the term “when” in claim 1, line 11 is very general. With respect to claim 2, the term “simultaneously” is indefinite as discussed above.

3. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Slater et al (U. S. Patent No. 6,157,435). Slater et al discloses in figures 1A and 1B at least one photographic processing site including developer 30. Column 9, lines 19-231, discloses an image scanner an image scanner 41 which can provide image characteristic data on such characteristics as image density, color balance, or contrast. These would be photographic printing conditions. Column 10, lines 47-67, disclose a color paper developer 100 and finishing station 120 which make prints

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121. Column 16, lines 45-60 disclose that the customer can reorder more prints based on the conditions of the previous printing. With respect to claim 2, the term "simultaneously" is indefinite as discussed above.

Claim Rejections - 35 USC § 103

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Garfinkle et al or Slater et al. Garfinkle et al and Slater et al disclose the invention as claimed except for specifically disclosing erasing the photographic printing condition stored in the database after a predetermined period of time. It is old and well known to erase information in databases after a predetermined amount of time from putting the information into the database for the well known purpose of freeing up storage space. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to erase the photographic printing conditions stored in the databases in Garfinkle et al or Slater et al in view of this old and well known principle for the purpose of freeing up storage space.

Conclusion

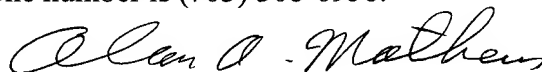
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The European Patent documents EP 0 856 972 A2 and EP 0 878 956 A1 are cited to show other multiple processing sites and centers having databases.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan A. Mathews whose telephone number is (703) 308-1706. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on (703) 308-2847. The fax phone numbers for the organization where this application or proceeding is assigned are 305-3431 for regular communications and 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Alan A. Mathews
Primary Examiner
Art Unit 2851

AAM
May 14, 2002